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Patent
259/225

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Russell E. Evans et al.

Serial No.: 09/804,785

Filed: March 13, 2001

For: POLARIZED EYEWEAR USING
HIGH IMPACT, HIGH OPTICAL-
QUALITY POLYMERIC
MATERIAL

Group Art Unit: 2872

Examiner: Fineman, Lee A.

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REQUEST FOR RECONSIDERATION UNDER 37 CFR 1.111

Commissioner for Patents
Washington, D.C. 20231

Sir:

In response to the 5/30/2002 Office Action, Applicants hereby make a request for reconsideration under 37 CFR 1.111 as to the restriction of claims 1-30.

The 5/30/2002 Office Action improperly requires the Applicants to further elect a species within Inventions I and II. MPEP 808.01(a) sets forth an election of species is required only where there is no disclosure of relationship between the species (see MPEP 806.04(b)). Similarly, MPEP 806.04(g) sets forth:

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(37 C.F.R. §1.8(a))

I hereby certify that this paper (along with any referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as First Class Mail in an envelope addressed to Commissioner for Patents, Washington, D.C. 20231.

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Claims to be restricted to different species must be mutually exclusive. The general test as to when claims are restricted, respectively, to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. This is frequently expressed by saying that claims to be restricted to different species must recite the mutually exclusive characteristics of such species.

MPEP 806.04(f) (emphasis added).

I^d The **nine** species required set forth in Invention I and the **eleven** or so species set forth in Invention II have a disclosed relationship and are not mutually exclusive of one another. Indeed, the Office Action sets forth different “species” that are not only overlapping limitations, but also overlapping claims. For example, in Invention I, “Species V” has in it claim 6, and so does “Species VI” and “Species VII.” Similarly, in Invention II, “Species I” includes claim 13, and so does “Species II,” “Species III,” “Species IV,” and “Species V.” Other such instances are readily apparent but are not set forth here. In short, the Office Action, on its face, establishes a clear relationship between the “species.”

Since the present restriction is not in compliance with the requisites of the MPEP, Applicants respectfully request that the restriction regarding further election between the species be removed.

Applicants also submit that claim 13 is generic pursuant to MPEP 806.04(d). The claim reads on each of the alleged species set forth by the Office Action. Since the present restriction is deficient in this respect as well, Applicants respectfully request that the Examiner acknowledge that claim 13 is indeed generic.

In light of the foregoing, Applicants provisionally elect Invention I drawn to "Species I."

Respectfully submitted,

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Dated: June 28, 2002

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